



ATTACHMENT A

Remarks

By this Amendment, independent claims 1 and 8 as well as dependent claims 5 and 6 have been amended to better define the invention. It is submitted that the present application is in condition for allowance for the following reasons.

Initially in the *Claim Rejections - 35 USC § 112* section of the outstanding Office Action, independent claims 1 and 8 were rejected for failing to comply with the written description. In particular, the examiner stated that the claim limitation that the first and second instants of time are separated by a length of time that is "irrelevant of initial conditions" was not described in the specification in such a way to reasonably convey to those of ordinary skill that the inventor had possession of such an invention. This rejection is based on two problems as noted by the examiner: 1) that the specification does address the relationship between the activation of the actuators in relation to initial conditions; and 2) that one skilled in the art would not know what initial conditions are being referred to.

By this Amendment, claims 1 and 8 have been amended to overcome the indefiniteness (second) part of this rejection by use of the phrase "of the three seat parts" following "initial conditions" to make definite what initial conditions are being referred to. It will also be noted that "independent" has been substituted for "irrelevant" in referring to the "initial conditions of the three seat parts". The use of the term "independent" seems more accurate and common in the art, and has thus been chosen for that reason even though both terms are largely equivalent in this context.

It is submitted that those of ordinary skill in the art would have appreciated that the inventor was in possession of this aspect of the invention for a number of reasons, including at least the following.

- Were the operation of the present invention not “independent” of initial conditions, such initial conditions would have been mentioned – as they are in various of the prior art references cited in the present application. Those of ordinary skill would appreciate that the present invention is either dependent on initial conditions (or some initial conditions) or not; so that the absence of any mention of any initial conditions clearly means that there are none.
- The above reasoning is further reinforced by the fact that the specification does positively describe “undesirable intermediate configurations” which would otherwise be possible without the present invention. This evidences that the final predetermined conditions and intermediate conditions were all considered, so it would be highly unlikely that the initial conditions were not also considered – which is even more unlikely when the level of those of ordinary skill is considered which in this field of invention would be more than a mere technician.
- The object of the invention is clearly that of moving a seat from any of “numerous configurations” to one (or more) predetermined configurations. Such an object would not be obtained if there were any initial conditions which defeated this object.
- Figure 2 provides a flowchart of the invention which would clearly show to those of ordinary skill that no initial conditions are considered.
- Figures 3 and 4 show a graphical representation of the operation of the invention at two extremes, which by comparison show that the numerous conditions therebetween would be operational and such numerous conditions would be independent of any initial conditions.

Thus, it is submitted that those of ordinary skill in the art would have readily appreciated from the entire application that the present invention functions “independent of the initial conditions of the three seat parts”.

It may be that the examiner in making this rejection is relying on the fact that the limitation or an equivalent is not explicitly mentioned in the application. However, in a similar situation in the case of In re Wright, 9 USPQ2d 1649, 1651 (CAFC 1989) the court stated as follows:

[quoting from another case] ‘the claimed subject matter need not be described in *haec verba* in the specification in order for that specification to

satisfy the description requirements.’ The fact, therefore, that the exact words ... are not in the specification is not important.

In this case, the limitation was that microcapsules were “not permanently fixed”. The court held that this was clear “from the essence of the original disclosure” which taught how the microcapsules were moved. The court then went on to say that in view of such movements “the specification does unequivocally teach the absence of permanently fixed microcapsules”.

In a similar case, All dental Prodx LLC v. Advantage Dental Products Inc., 64 USPQ2d 1945, 1948 (CAFC 2002), the court repeated the above analysis and went on to state “It is also clear what the invention is not.” In that case, the questioned term was “unidentifiable mass”, and the court held that it was clear that the application did not involve “an identifiable form or shape”.

Thus, in the same manner as in both of the above noted cases, it is clear that the present application unequivocally teaches that there are no initial conditions for the operation of the present invention, or in other words that the present invention is not dependent on initial conditions, so that the use of the noted phrase is part of the invention and should be allowed to be used in the claims.

The second part of this rejection as noted above addressed the question of what initial conditions are being referred to. While it is submitted that this would have been evident to those of ordinary skill for much of the same reasons as mentioned above, claims 1 and 8 have been amended to recite that it is the initial conditions of the “three seat parts” which are being referred to.

In view of all of the above, it is submitted that the rejection of claims 1 and 8 under § 112 has been overcome.

Also in the *Claim Rejections - 35 USC § 112* section, dependent claims 5-7 were rejected for being indefinite. In particular, the examiner asserted that the phrase including “phase of joint operation of the two activators” in claims 5 and 6 was not definite. While this phrase obviously referred back to the phrase “operating the two actuators jointly”, for better definiteness claims 5 and 6 have been amended to repeat the initially recited step exactly. Thus, it is submitted that claims 5-7 are now definite so that this rejection should not be withdrawn.

In the *Claim Rejections - 35 USC § 102* section, independent claims 1 and 8 were both rejected under 35 USC § 102 as being anticipated by either the Sakakibara patent or the (newly cited) Kitamoto patent; while claims 2-6 dependent from claim 1 and claim 9 dependent from claim 8 were also rejected under 35 USC § 102 as being anticipated by either or both the Sakakibara patent or the Kitamoto patent [note: dependent claim 7 was not rejected over art]. However, for the following reasons, it is submitted that these claims are allowable over these references.

In the present invention, as discussed extensively above, the second actuator is activated at a second instant subsequent to the first instant and separated from the first instant by a fixed predetermined length of time which is independent of initial conditions of the three seat parts. In the both of the prior art Sakakibara patent and Kitamoto patent, the second actuator is activated only after the first actuator is stopped due to a limit switch which is turned on by the element driven by the first actuator when this element reaches the limit switch.

The examiner seems to have appreciate this distinction over the art, as the rejection based on the top part of column 14 of the Sakakibara patent was withdrawn –

though an equivalent recitation of column 14 at lines 29-34 is now used. Perhaps the best way to show the differences between the two references is by comparing how the device of the Sakakibara patent operates compared to the present invention as recited in the claims. Thus, in claims 1 and 8 there is the recited step of:

activating a second actuator at a second instant subsequent to the first instant and separated from the first instant by a fixed predetermined length of time which is independent of initial conditions of the three seat parts. [with added emphasis]

The device of the Sakakibara patent operates by:

activating a second actuator at a second instant subsequent to the first instant and separated from the first instant by an undetermined [i.e., **not fixed**] predetermined length of time which is dependent [i.e., not independent] of initial conditions of the three seat parts. [with added emphasis]

Thus, there is clearly a distinction between the operation as claimed in the present invention and that of the Sakakibara patent.

Further, in describing the operation of the Sakakibara patent, the examiner states as follows in the *Response to Arguments* section:

Sakakibara et al. disclose that the actuator MT(22) at step S112 actuates the seat back forward **until** limit switch LS(27) is turned on and then actuator MT(21) actuates the seat cushion backward immediately following the movement of the first actuator. Therefore, the actuating of the actuator MT(22) at a first instant and the actuating of actuator MT(21) at a second instant is separated by a fixed predetermined length of time that is invariable. [emphasis added]

Unfortunately, this is either a misstatement or the examiner has failed to appreciate the very essence of the present invention.

In making this statement, the examiner acknowledges that the second actuation occurs when the limit switch LS(27) is turned on. Obviously, the instant when that limit switch is turned on will unavoidably depend on where the seat back is initially located in

relation thereto (an INITIAL CONDITION!). Thus, the time between the initial actuation of MT(22) and the subsequent (limit switch) actuation of MT(21) will depend on the time of travel of the seat back. It therefore follows that the limit switch actuation of MT(21) is not “fixed”, but variable (as stated above and repeatedly).

In view of the above, the examiner’s statement

the actuating of the actuator MT(22) at a first instant and the actuating of actuator MT(21) at a second instant is separated by a fixed predetermined length of time that is invariable

is plainly incorrect in any sense which those of ordinary skill in the art would use such terms (for the common definitions of such terms, please see the previous Amendment).

This acknowledgement that activation by a limit switch does not effect a “fixed predetermined length of time” has already accepted by the examiner with respect to the same process of actuation of actuators 233 and 438 as readily evidenced by the withdrawal of the prior rejection based on those elements (and as agreed at the interview of November 21, 2003, as noted in the responding Amendment thereto of November 24, 2003). Thus, it seems that the examiner must have misread the Sakakibara patent.

If the examiner means to state that the actuation of the second actuator MT(21) occurs at a fixed predetermined length of time that is invariable after limit switch LS(27) is turned on (i.e., immediately thereafter), this would be true but **irrelevant** to what is being claimed. It is not an actuation of one actuator following another which is being claimed; it is the fixed predetermined length of time between the “instant” of actuation of the first actuator and the “instant” of actuation of the second. In the Sakakibara patent, those two “instants” are dependent on the initial conditions, and the time period in between is never “a fixed predetermined length of time which is independent of initial conditions”.

Therefore, for all of the foregoing reasons, it is submitted that independent claims 1 and 8 are allowable over the Sakakibara patent.

With respect to the rejection of independent claims 1 and 8 over the (newly cited) Kitamoto patent, the examiner has described a process of movement of the seat disclosed therein which is substantially identical to that of the Sakakibara patent discussed above. In particular, the examiner notes that a first actuator is actuated, a means [limit switch or the like!] is used “for detecting (Fig. 15) the first actuator has stopped after the first actuator has reached a predetermined position” [emphasis added], and then a second actuator is activated. [It will also be noted that actuator 140 mentioned by the examiner is a mechanical linkage or “driving mechanism”, and hence is not an actuator.]

Thus, for the same reasons as discussed above by which the similar process of movement of the Sakakibara patent does not anticipate or make obvious independent claims 1 and 8, it is submitted that the same described process of the Kitamoto patent also does not anticipate or make obvious claims 1 and 8.

Therefore, for all of the foregoing reasons, it is submitted that independent claims 1 and 8 are neither disclosed nor made obvious by the Sakakibara patent or the Kitamoto patent so that these claims are now allowable. For these same reasons, it is submitted that dependent claims 2-7 and 9 are similarly allowable. It is also noted (as mentioned above) that dependent claim 7 was not rejected over art and thus remains allowable for that reason.

For all of the foregoing reasons, it is submitted that the present application is in condition for allowance and such action is solicited.